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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,430	10/17/2001	Linden H. McClure	10015149 -1	6660

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

KOBERT, RUSSELL MARC

ART UNIT PAPER NUMBER

2829

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/982,430

Applicant(s)

MCCLURE ET AL

Examiner

Russell M Kobert

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. A good example of such a title, although not necessarily related to this specific case, could be *"Method and Apparatus for Passive Optical Characterization of Semiconductor Substrates Subjected to High Energy (MEV) Ion Implantation Using High-Injection Surface Photovoltage."*

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the instant application, the Abstract contains more than 150 words.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yagi et al (6019616); (see Figure 3).

5. Claims 1-3 and 8-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cole et al (5548223) or Chrzanowski et al ("Surface-Connected Connector," IBM Technical Disclosure Bulletin, Vol. 21, No. 12, May 1979, page 4508).

6. Claims 1-3 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Martucci et al (5653601).

Martucci et al anticipates (Figure 3) a printed-circuit board (PCB) test jack (10), comprising: a body portion (44) arranged to interface with an external test probe (52; see Figure 5), at least one surface mount conductor (26) connected to said body portion and arrayed for attaching to corresponding surface pads (16a) on the surface of a PCB (12), and a signal conductor (24) connected to said body portion, comprising a single through-hole pin for insertion into a corresponding single through-hole (14) on said PCB as recited in claim 1.

As to claim 2, having a body portion cylindrical wherein at least one surface mount conductor comprises one surface mount conductor which extends approximately perpendicularly from said body portion is clearly shown in Figure 3.

As to claim 3, having a body portion cylindrical wherein at least one surface mount conductor comprises two surface mount conductors (26) which extend approximately perpendicularly from opposite sides of said body portion such that said surface mount conductors are 180 degrees apart is clearly shown in Figure 3.

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As to claims 8, 9 and 10 the added limitations to the printed circuit board (PCB) are not considered to further limit the invention as claimed, specifically the printed-circuit board test jack, and as such are considered anticipated by Martucci et al.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martucci et al (5653601).

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a cylindrical body portion wherein at least one surface mount conductor comprises three surface mount conductors which extend approximately perpendicularly from said body portion such that said surface mount conductors are 120 degrees apart as mentioned in claim 4 and to have provided a cylindrical body portion wherein at least one surface mount conductor comprises four surface mount conductors which extend approximately perpendicularly from said body portion such that said surface mount conductors are 90 degrees apart as mentioned in claim 5 because these claims demonstrate limiting conditions which can be determined by routine experimentation and are considered to be within the scope of the invention as disclosed in Martucci et al.

Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Swain et al., 33 C.C.P.A. (Patents) 1250, 156 F. 2d 239, 70 USPQ 412 ; Minnesota Mining and Mfg. Co. v. Coe, 69 App. D.C. 217, 99 F. 2d 986, 38 USPQ 213 ; Allen et al. v. Coe, 77 App. D. C. 324, 135 F. 2d 11, 57 USPQ 136 .

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Perino et al (6273759) and Noble (6442832) show test jacks *for* surface mount connection to a printed circuit board.

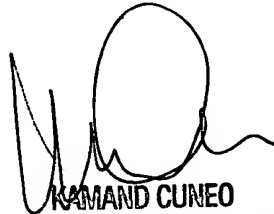
11. A shortened statutory period for response to this action is set to expire three month(s) from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kobert whose telephone number is (703) 308-5222.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Russell M. Kobert
Patent Examiner
Group Art Unit 2829
August 22, 2003



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